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In re Application of	:
VAN SAARLOOS, Paul	: DECISION ON
US Application No.: 09/719,726	:
PCT Application No.: PCT/AU99/00479	: PETITION
Int. Filing Date: 17 June 1999	:
Priority Date: 17 June 1998	: UNDER
Attorney's File Reference: A33827 PCT USA	:
For: Z AXIS TRACKER	: 37 CFR 1.47(b)

This decision is in response to the submission by The Lions Eye Institute of Western Australia Incorporated (LEI) entitled "RENEWED PETITION UNDER 37 CFR 1.47(b)", filed 14 June 2002, which requests acceptance of the application without the signature of sole inventor Paul Van Saarloos (Van Saarloos).

BACKGROUND

On 10 December 2001, this Office mailed a decision dismissing LEI's petition under 37 CFR 1.47(b) filed 30 July 2001. The decision stated that the petition did not include sufficient proof either of proprietary interest or that the nonsigning inventor refused to execute the declaration. Specifically, the decision stated that the LEI should submit a statement of a person with firsthand knowledge attesting to the fact that the invention was made by Van Saarloos while employed by LEI, or otherwise establish proprietary interest. Further, the decision stated that a copy of the application papers, including the description, claims, and drawings, should be sent to the last known address of Van Saarloos or his agent. Alternatively, the decision added, that if LEI concludes that Van Saarloos' conduct constitutes a refusal, all facts upon which that conclusion are based should be stated in an affidavit or declaration accompanied by any available documentary evidence.

On 14 June 2002, LEI filed, inter alia, the following papers:

- 1) a renewed petition under 37 CFR 1.47(b);
- 2) a \$720 check for a four-month extension of time under 37 CFR 1.136(a);

3) a statement signed by Jeffrey Constable (Constable) indicating that he has first hand knowledge of the fact that the invention, which is the subject of above-identified US application, was made by Van Saarloos while he was employed by LEI;

3) a statement, signed by Gregory Joseph Noonan (Noonan), indicating that although he was uncertain whether the US application papers forwarded to Van Saarloos for signature were accompanied by a copy of the specification, claims, and drawings, he was aware that from early 1999 to about May 2000 Van Saarloos was responsible for managing LEI's patent matters being handled by Noonan and that after examining his files he determined that Van Saarloos reviewed the draft specification for the above-identified international application in June of 1999.

DISCUSSION

Section 409.03(d) under the heading "REFUSAL TO JOIN" states in part:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

* * * * *

It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

There is no evidence that the US application papers forwarded to Van Saarloos included a complete copy of the application including copies of the specification, claims, and drawings in addition to declaration and power of attorney and assignment papers. In his statement however, Noonan asserts that from early 1999 to about May of 2000 Van Saarloos was responsible for managing LEI's patent matters being handled by Noonan and that Van Saarloos was fully informed and knowledgeable as to the content of the above-identified US application. Noonan further asserts that after examining his files he determined that Van Saarloos reviewed the draft specification for the above identified application in June of 1999.

It is not clear that Van Saarloos understands exactly what he is being asked to sign if the papers forwarded to him for signature do not include the specification, claims, and drawings. Although, Van Saarloos was informed and knowledgeable as to the content of the above-identified international application in June 1999 he may not understand exactly what he is now being asked to sign based merely on the assignment papers and combined declaration and power of attorney forwarded to him on 01 December 2000 and to his agent on 21 May 2002.

The statement of Constable suffices to show the proprietary interest of LEI in the subject matter of the above-identified application.

CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within ONE (1) MONTH from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. No extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response to this decision will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office



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